



Application No. 10/816,827
Docket No. 0579-1036

AMENDMENTS TO THE DRAWINGS:

The replacement sheet in the Appendix includes changes to Figure 14C. This sheet, which also includes Figures 14A and 14B, replaces the original sheet including Figures 14A-C. In Figure 14C, the previously omitted base extension and blocking through-hole have been added. Support for the amendment is found on page 14, lines 30-34, which have been amended into conformance.

REMARKS

The courtesy afforded the applicant's representative by Examiner Taylor during the telephone interview on December 20, 2006 is acknowledged with thanks. During the interview, applicant's representative pointed out the patentability of claims 43 and 53, confirmed that the drawing correcting herein would be acceptable, and discussed a further amendment to the claims in which the small card is defined to be entirely within the pocket. The present amendment amends claims 43 and 53 in this manner and makes other conforming amendments to place the application in condition for allowance.

The specification and drawings have been amended to show and refer to the blocking through-hole discussed on page 14, lines 30-34. Reconsideration and withdrawal of the objection to the drawings is respectfully requested.

The indication that claims 47 and 57 include patentable subject matter is acknowledged with thanks.

Claims 43-46, 48-56, and 58-62 were rejected as unpatentable over VEDDER et al. 6,561,432 in view of BASHAN et al. 6,719,206 and YAMAGUCHI et al. 7,000,842. Reconsideration and withdrawal of the rejection are respectfully requested.

The Official Action acknowledges that VEDDER et al. do not disclose or suggest that the small card that is detachable from the preliminary base card at the weakened line includes an

antenna and a microcircuit. The Official Action relies on BASHAN et al. for the suggestion to modify VEDDER et al. to include this feature and relies on YAMAGUCHI et al. for the suggestion to place the card in a pocket of a base.

However, it is not believed that one of skill in the art would make this combination. VEDDER et al. relates to a portable data carrier (ID-1 card) with a detachable mini-card (ID-000 card). The mini-card is for a mobile phone that already includes an antenna. One of skill in the art would not be motivated to add an antenna to the mini-card in VEDDER et al. because the mini-card does not need one; the device in which the mini-card is used includes the antenna.

The Examiner noted during the interview that the mini-card VEDDER et al. is not limited to use in a mobile phone. However, the reference makes no suggestion to use the mini-card in something other than a mobile phone and does not teach one of skill in the art that the mini-card is useable with a device that does not already have an antenna. The reference is valid for what it teaches, and it is improper to extend the reference beyond what is taught therein. To do so is improper hindsight application of that which is taught only by the present inventor. The present inventor, not the reference, teaches the use of a small card in a device that does not already have an antenna. The test under §103 is what the reference actually

teaches, not what the reference could have disclosed.

Further, the antenna in BASHAN et al. is not part of a detachable card portion. The antenna 40 is on the underside of chip carrier module 10 that includes chip 30 (Figure 2). The chip carrier module 10 is retained in a cavity 12 of a support medium 20. The module 10 is not detachable from the support medium 20 and there is nothing in the reference to suggest the antenna may be part of a detachable mini-card (e.g., see column 5, lines 24-25, wherein the chip carrier 10 is glued into the cavity 12).

The Examiner noted during the interview that BASHAN et al. is relied upon for the suggestion to place an antenna on a small card. However, the reference teaches that the antenna may be placed on a non-detachable part of a larger card. The large card provides protection and support for the non-detachable part and for the antenna. One of skill in the art would not learn from this reference that the antenna may be placed on a small card that is detachable from a larger card.

Thus, one of skill in the art would not make the suggested combination because the mini-card in VEDDER et al. does not need an antenna and the antenna of BASHAN et al. is not part of a detachable card portion. VEDDER et al. do not teach that the mini-card can be used with a device that does not have an antenna and BASHAN et al. do not teach that the antenna on

the non-detachable portion may also be used on a detachable portion. Forcing the references to fit the invention by asserting that they do teach these features is improper hindsight application of that which is taught only by the present inventor.

YAMAGUCHI et al. is relied upon for the suggestion to hold the small card in a pocket of a base. The present amendment provides that the small card is held entirely within the base. YAMAGUCHI et al. do not disclose that the card is held entirely within the base. See, for example, the various figures that all show the card extending from the pocket. None of the figures show the card entirely within the pocket. Thus, the amended claims avoid the combination that includes YAMAGUCHI et al.

Further, there is no suggestion in the proposed combination to include a small card with an antenna entirely within the base. The presence of the antenna on the small card makes the small card fully operational within the pocket. None of the references disclose or suggest a fully operational small card held entirely within the pocket (see also claims 51 and 61).

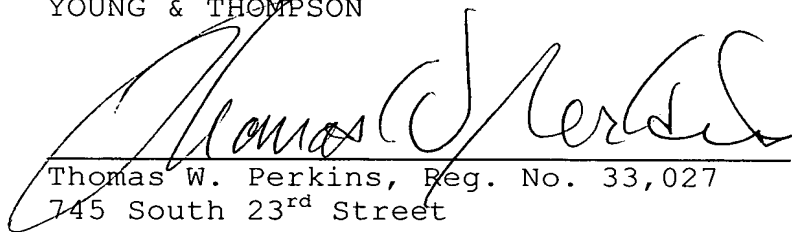
The amended claims thereby avoid the rejection under §103.

In view of the present amendment and the foregoing remarks, it is believed that the present application has been placed in condition for allowance. Reconsideration and allowance are respectfully requested.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

YOUNG & THOMPSON

A handwritten signature in black ink, appearing to read "Thomas W. Perkins", is written over a horizontal line.

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TWP/lk

Appendix

- one replacement drawing sheet.